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#25/Appeal Brief
k. Mitra -
11/12/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:	:	
	)	
Jan Abraham VAN ASSELT	:	Atty. Ref: 112134-00102
	)	
Serial Number: 09/582,556	:	Group Art Unit: 3711
	)	
Filed: August 22, 2000	:	Examiner: Mitra Aryanpour
	)	
For: BALL GAME APPARATUS	:	

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APPEAL BRIEF

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Real Party in Interest

This appeal is taken from a final rejection of pending claims submitted for examination in U.S. Patent Application Serial No. 09/582,556, which was filed in the name of Jan Abraham Van Asselt ("the Van Asselt Application" or "application"), the real party in interest.

Related Appeals and Interferences

No other appeals or interferences are known to Appellant or Appellant's legal representatives that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims

Claims 1-5, 7-26 and 28-35 are pending in the application. The pending claims were finally rejected in an Office Action mailed to Appellant's legal representatives on May 7, 2003. Those rejected claims are being appealed.

A listing of the claims is attached as Appendix 1.

A copy of the May 7, 2003, Office Action ("Office Action") is attached as Appendix 2.

A copy of an Interview Summary mailed to Appellant's legal representatives on May 23, 2003, which is related to the Office Action, is attached as Appendix 3.

Status of Amendments

No amendments to the claims were filed subsequent to the final rejection of the claims in the Office Action. All amendments prior to the final rejection have been entered.

Summary of Invention

The Van Asselt application discloses an apparatus for practicing swinging a golf club, baseball bat, tennis racket and the like by one or more players. Figures 1 through 4 of the application, reproduced below, illustrate various embodiments of the invention. A concise explanation of the invention follows. A more detailed description and explanation of the invention may be found beginning on page 6 of the application.

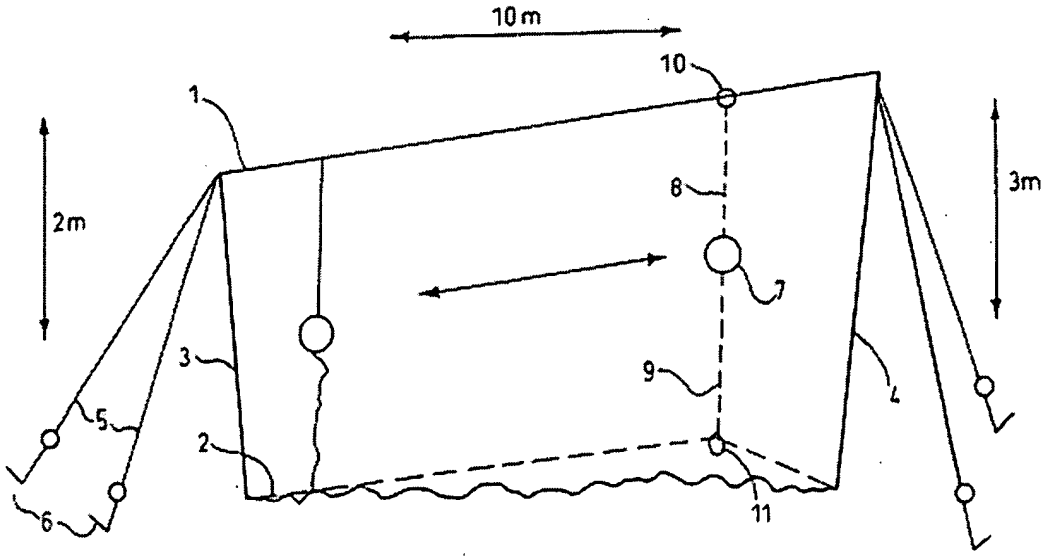


FIG.1.

As shown in Figure 1 above, in a preferred embodiment, the invention includes an upper guideway 1, a lower guideway 2, two upright supports 3, 4, which are spaced apart approximately 10 meters as shown, four inclined guide ropes 5, four ground engaging pegs 6, a ball 7, two inelastic lines 8, 9, and two loops or rings 10, 11.

In the preferred embodiment, the point of connection of the upper guideway to the top of the upright support 3 on the left of the apparatus is about 2 meters above the ground. The point of connection of the upper guideway to the top of the upright support

4 on the right is about 3 meters above the ground. Thus, the upper guideway is inclined from one side of the apparatus to the other.

The upright supports are held in position by the guide ropes. The guide ropes are attached, on one end, to the tops of the upright supports and are attached, on the other end, to the ground by use of the pegs. The inelastic lines are attached, on one end, to the upper and lower guideways by use of the loops/rings, and are attached, on the other end, to the ball.

As described in the application, there are two positions of the lower guideway, shown in full and broken lines. In the starting or striking position of the ball, the inelastic lines and the lower guideway are shown by the full line. In that position, the ball is suspended from the upper guideway by the top inelastic line 8. The bottom inelastic line 9 and the lower guideway are shown as "wavy" lines to indicate the lines are not taut (in contrast to the top inelastic line 8). A player stands near the lower guideway at its point of connection to the upright support 3 and strikes the ball with a racket, bat, etc. The force of the strike sends the ball to the right. The loops/rings 10, 11 and the inelastic lines 8, 9 connected thereto, traverse a portion of the length of the upper and lower guideways toward the limiting position shown by the broken line. That limiting position is the point where the linear distance between the upper guideway and the lower guideway is the same as the linear distance between the point where the top inelastic line 8 attaches to the upper guideway by the use of the loop 10 and where the bottom inelastic line 9 attaches to the lower guideway by the use of the loop 11. Once the distance between the ends of the inelastic lines 8, 9 (the lower guideway now being in its raised position shown in broken line) becomes limiting in relation to the distance between the upper and the lower guideways, the lines 8, 9 slow down, stop and the ball 7 is deflected back along the upper and lower guideways to return to the player.

As shown in Figure 2 below, a wall 12 may be used in place of one of the upright supports and guide ropes/pegs.

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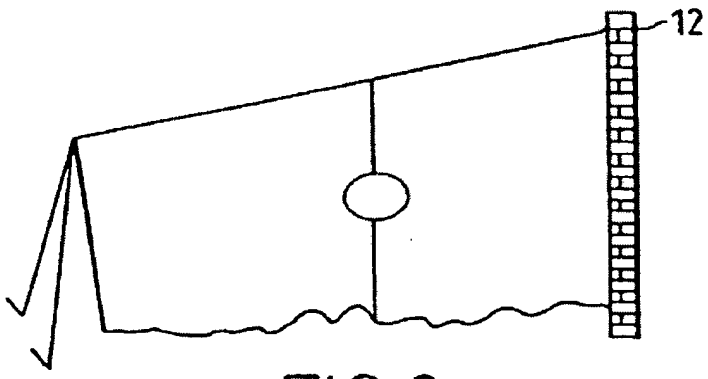


FIG.2.

As shown in Figure 3, two walls 14 may be used in place of the upright supports and guide ropes/pegs.

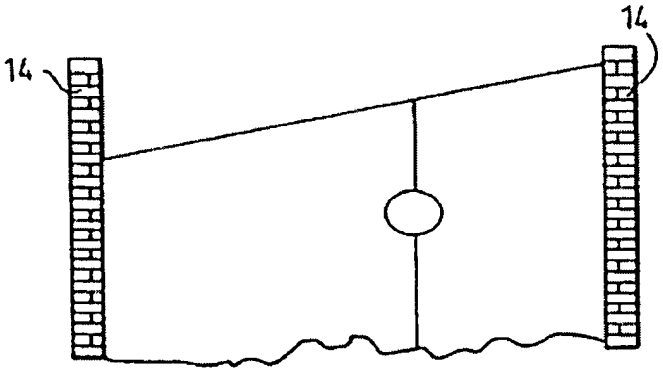


FIG.3.

The embodiment of the invention as shown in Figure 4 is the same as the embodiment of the invention shown in Figure 1 except the upper and lower guideways are generally parallel to accommodate two players.

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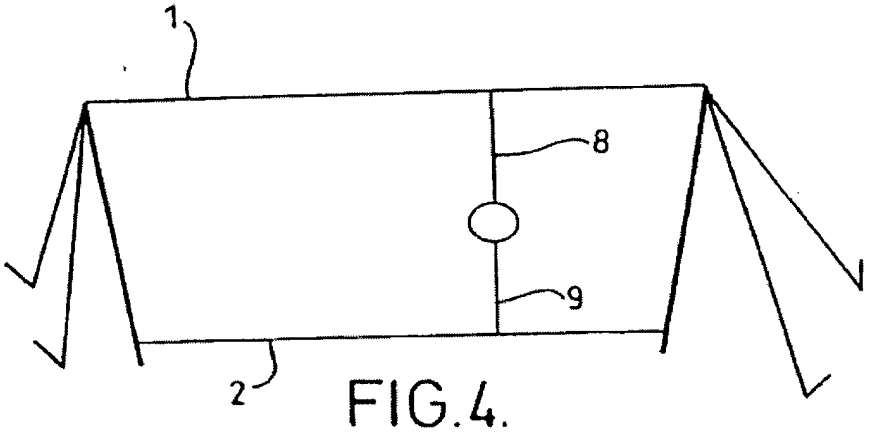


FIG.4.

Issues

The issues for review in this Appeal are as follows:

A. Whether claims 29, 30, 32, 33 and 35 satisfy the requirement of 35 U.S.C. § 112, first paragraph. In particular, whether the recitation of "slack" in the lower guideway is adequately described in the written description in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the application was filed, had possession of the claimed invention.

B. Whether claim 8 satisfies the requirement of 35 U.S.C. § 112, first paragraph. In particular, whether the recitation of a lower guideway being "adjustably engaged to the stable support" is adequately described in the written description in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the application was filed, had possession of the claimed invention.

C. Whether claims 1-5, 7-9, 11-15, 18, 19, 28 and 34 are patentable, under 35 U.S.C. § 103(a), over U.S. Patent No. 3,630,521 to *Lingbeek* in view of U.S. Patent No. 3,086,775 to *Albert* and U.S. Patent No. 5,713,805 to *Scher et al.* or in the alternative to U.S. Patent No. 5,460,364 to *Ring*.

D. Whether claims 10, 16, 17, 20-26, 29-33 and 35 are patentable, under 35 U.S.C. § 103(a), over *Lingbeek* in view of *Albert* and *Scher et al.* or in the alternative to *Ring*, as applied to claim 1, and further in view of U.S. Patent No. 4,138,107 to *Janis*.

Grouping of Claims

The claims presented on appeal do not "stand or fall together." The claims have not been properly rejected based on the disclosed subject matter and the cited references used in the rejections. The claims are grouped as set forth below in the Argument.

Argument

A. It is error to reject claims 29, 30, 32, 33 and 35 under 35 U.S.C. § 112, first paragraph

1. Summary of the rejection

Claims 29, 30, 32, 33 and 35, which were added to the application by an amendment, were rejected because of the term "slack." That specific term was not used in the written description at the time the application was filed. Claim 29 recites "wherein the lower guideway between the first and second upstanding stable supports is slack when the ball is at rest." Similarly, claim 32 recites, in part, "wherein the lower guideway is slack when the ball is at rest." Claims 29 and 32, therefore, are directed to the slack feature of the lower guideway 2, which is shown in Figure 1.

In contrast, claims 30, 33 and 35 are directed to the slack feature of the bottom inelastic line 9, also shown in Figure 1. Claim 30 recites "wherein the portion of the one or more upstanding lines between the ball and the lower guideway is slack when the ball is at rest" (the "inelastic line 9" described in the specification is synonymous with the "upstanding line" recited in the claim). Similarly, claims 33 and 35 recite, in part, "wherein the lower upstanding line is slack when the ball is at rest."

The rejection of claims 29, 30, 32, 33 and 35 is based on the assertion that "there is insufficient support" and "no clear and definite support" in the disclosure for the lower guideway to be slack. Attach. 2 at 2-4. The rejection is further based on the assertion that "a mere reference that the lower guideway is shown in two positions does not provide support for the guideway to be 'slack.'" Id. Moreover, it is asserted that "[n]o reference in the original specification and/or claims was made to have the lower guideway 'slack,' no additional explanation has been given in the original specification and/or claims as to the relationship of the 'slack' guideway to the remainder of the apparatus, and why it would be desirable to have such a feature, and how it would differ from a taut line?" Id. at 2-4 to 2-5. These assertions are directed only to the slack

limitation recited in claims 29 and 32 (i.e., the lower guideway) and not to the slack limitation recited in claims 30, 33 and 35 (i.e., the upstanding line).

2. The specification and drawings describe the subject matter defined by claims 29 and 32.

The rejection of claims 29 and 32, under 35 U.S.C. § 112, first paragraph, is in error because the disclosure provides adequate support for the claim term "slack" in the lower guideway and one of ordinary skill in the art would understand from the specification why and how the lower guideway is not taut when the ball is at rest.

35 U.S.C. § 112, first paragraph, provides that the "specification shall contain a written description of the invention." To satisfy the written description requirement, "the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed." Cordis Corp. v. Medtronic AVE Inc., 67 U.S.P.Q.2d 1876, 1885 (Fed. Cir 2003); Lockwood v. Am. Airlines, Inc., 41 U.S.P.Q.2d 1961 (Fed. Cir. 1997). "The disclosure as originally filed does not, however, have to provide *in haec verba* support for the claimed subject matter at issue." Id.; Crown Operations International Ltd. v. Solutia Inc., 62 U.S.P.Q.2d 1917, 1922 (Fed. Cir. 2002). Drawings alone may satisfy the written description requirement. See, e.g., Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991).

In this case, the specification and the drawings of the Van Asselt Application clearly contain the identifying characteristics of the slack feature of the claimed invention. Consider the embodiment of the invention shown in Figure 1. There are shown "[t]wo positions of the lower guideway..., these being shown in full line and broken line." Van Asselt Application at 6. There is also a two-headed arrow between the ball 7 in the right and left positions. A broken line in a drawing, like in Figure 1, is understood to mean an alternate position from the position shown by a solid line. See 37 C.F.R. § 1.84(h)(4) (defining the practice of depicting alternate positions on a drawing). A two-headed arrow is understood to mean a change of position or direction of movement. See 37 C.F.R § 1.84(r)(3) (defining the practice of depicting movement

on a drawing). Thus, Figure 1 clearly "describes" an apparatus with structure that moves from one position to an alternate position. As discussed previously, the specification refers to the alternate position represented by the broken line as a "raised" position.

The only way the lower guideway can move from the original position shown by the wavy solid line to the alternate "raised" position shown by the broken line, when the ends of the lower guideway are fixed, is to provide either slack in the guideway or by using an elastic material. The lower guideway is described in the specification as a plastic-coated cord or wire-like structure. Van Asselt Application at 6; see also claim 14 ("Apparatus according to claim 13 wherein the upper and lower guideways or the reciprocating means are made of plastics covered cord or wire."). Thus, while one of ordinary skill in the art would conclude that a "cord" or "wire" possesses some inherent flexibility, that is, it is not a rigid line fixed between two points but instead can bend, the guideway is not elastic. Thus, the alternative explanation for the wavy solid line is that it represents "slack" in the lower guideway. In other words, the lower guideway is not taut in the resting position.

Moreover, contrary to the Examiner's assertion, the specification does indicate why the lower guideway is slack in the initial position and how that differs from a taut line. In fact, as described below, there is only one reasonable conclusion that one of ordinary skill in the art could make regarding the nature of the lower guideway as depicted by the two positions of the guideway shown in Figure 1. Consider a left-handed batter or golf player standing near the stable support 3 at the side of the apparatus with his back to an observer looking into the page of Figure 1. The batter is between the observer looking into the page of Figure 1 and the ball 7. As described in the specification on page 7, the distance between the guideways 1, 2, is less at the striking position than at the returning position. The force of the strike from the player sends the lines 8, 9 and the ball 7 along the upper and lower guideways 1, 2 toward the limiting position shown by the broken line in Figure 1. That is, if the player elevates the ball 7 into the air, as would be expected for a batter, golf player or tennis play

hitting the ball, the position of the lower guideway would also elevate as shown by the broken line relative to the solid wavy line. Once the distance between the ends of the lines 8, 9 (the lower guideway 2 now being in its raised position shown in broken line) becomes limiting in relation to the distance between the upper and lower guideways, the lines 8, 9 slow down, stop and the ball 7 is deflected back along the upper and lower guideways to return to the player who can then strike the ball again. In other words, the lower guideway is not taut before the ball is struck by the player. If there was no slackness in the lines 8, 9, there would be no movement of the ball from the striking position to the returning position of the invention shown in Figure 1 because of the use of inelastic lines. Thus, one of ordinary skill would understand that there is a difference between the slack guideway in the resting position and the taut guideway in the raised position shown in the embodiment of Figure 1.

Figures 2 and 3, which illustrate alternative upright supports (i.e., walls), also show a wavy solid line for the lower guideway. As described in the application, Figures 2 and 3 are only used to illustrate the alternative upstanding support feature of the invention. Van Asselt Application at 7. Thus, Figures 2 and 3 are consistent with the "description" of the invention shown in Figure 1 by showing the slack feature of the lower guideway.

In contrast, Figure 4 is described as an alternative embodiment of the invention where two players stand opposite each other at opposite ends of the apparatus. Van Asselt Application at 7. The application describes the upper and lower guideways in Figure 4 as "generally parallel" so the ball can be sent from one end of the apparatus to the other end by the players striking the ball. There is no need for slack in the lower guideway to provide a "limiting position" of the ball and the inelastic lines, as in the case of the embodiment described in Figure 1, such that the ball returns to the original position, because the two players provide the action necessary to return the ball to the other side of the apparatus. Thus, the embodiment of the invention shown in Figure 4 does not require the alternate position of the lower guideway as shown by the broken line in Figure 1. Accordingly, Figure 4 and the description of the embodiment shown in

Figure 4 are consistent with the notion that the wavy solid line in Figure 1 indicates that the lower guideway is slack at rest.

Given the disclosure in the drawings and specification as filed, there is adequate support for the claim term "slack" and a person of ordinary skill in the art would understand and recognize that Applicant had possession of the claimed invention at the time of filing the application. The fact that the term "slack" does not appear *in haec verba* in the disclosure as filed does not prevent its later use to describe what is shown and described in the original disclosure. Accordingly, it is error to reject claims 29 and 32 under 35 U.S.C. § 112, first paragraph.

3. The specification and drawings describe the subject matter defined by claims 30, 33 and 35

As described above, the basis for the rejection of claims 29, 30, 32, 33 and 35 is directed only to the slack limitation recited in claims 29 and 32 (i.e., relative to the lower guideway) and not to the slack limitation recited in claims 30, 33 and 35 (i.e., the upstanding/inelastic line 9 shown in Figure 1). Thus, there is no basis described in the Office Action supporting the rejection of claims 30, 33 and 35 under 35 U.S.C. § 112, first paragraph. See Attach. 2 at 2-4 to 2-5. For purposes of this Appeal, however, Appellant has treated the basis of rejection of claims 29 and 32 as being applicable to the slack limitation recited in claims 30, 33 and 35. See Attach. 3 at 3-4 (stating that all limitations did not need to be addressed to assert a rejection of a claim).

If the Board accepts the argument that the wavy solid line used to depict the lower guideway in Figure 1 represents slack in the lower guideway when it is at rest, it should also conclude that the wavy solid line used to depict the bottom inelastic line 9 (i.e., "upstanding line" in the claims) represents slack in that line as well. That is, the axial length of line 9, as measured between the point where it attaches to the ball 7, on one end, and the point where it attaches to the loop/ring 11, on the other end, must be greater than the linear distance between the bottom of the ball 7 and the loop or ring 11 when the apparatus is in the pre-struck position shown in Figure 1.

Accordingly, the drawings and specification describe the slack feature in sufficient detail that one skilled in the art would clearly conclude that the inventor invented what is claimed. Therefore, for the same reasons that it is error to reject claims 29 and 32, it is also error to reject claim 30 under 35 U.S.C. § 112, first paragraph.

B. It is error to reject claim 8 under 35 U.S.C. § 112, first paragraph

1. Summary of the rejection

Claim 8 recites "wherein the lower guideway is adjustably engaged to the stable support" (the recited stable supports are synonymous with the upright supports 3, 4 described in the specification). The rejection of claim 8 is based on the assertion that "the disclosure provides support for the lower guideway to be attached to the stable support but the specification does not provide support for the lower guideway to be adjustably engaged" (citing pages 3 and 4 of the application). Attach. 2 at 2-5. The rejection is also based on the assertion that "[a]s best seen from the drawings the lower guideway should be adjustably connected to the stable supports, but [the] specification indicates that the lower guideway are [sic; *is*] adjustably engaged with the ground." Id.

2. The specification and drawings describe the subject matter defined by claim 8.

The rejection of claim 8, under 35 U.S.C. § 112, first paragraph, is in error because the disclosure provides adequate support for the claim term "adjustably engaged to the stable support."

The test for compliance with 35 U.S.C. §112, first paragraph, is whether sufficient information is provided in the original disclosure to show that the inventor possessed the invention at the time of the original filing. Moba B.V. v. Diamond Automation Inc., 66 U.S.P.Q.2d 1429, 1439 (Fed. Cir. 2003); see also Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1115 (Fed. Cir. 1991). As previously stated, "the possession test requires assessment from the viewpoint of one of skill in the art." Id. (citing Union Oil Co. of Cal. v. Atlantic Richfield Co., 54 U.S.P.Q.2d 1227, 1232 (Fed.

Cir. 2000) ("The written description requirement does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed'") (citation omitted)). Where the record shows that the specification teaches one of skill in the art how to make and use an invention, it also should convince that artisan that the inventor possessed the invention. Id. An applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention. A specification may, within the meaning of 35 U.S.C. §112, first paragraph, contain a written description of a broadly claimed invention without describing all species that the claim encompasses. Cordis Corp. v. Medtronic AVE Inc., 67 U.S.P.Q.2d 1876, 1886 (Fed. Cir 2003) (citing cases).

In this case, Figure 1 shows the lower guideway attached to the upright supports 3, 4 at the point where the upright supports engage the ground. Figure 4, in comparison, shows the lower guideway attached to the upright supports at a point above the ground. Thus, as the Examiner correctly acknowledges in the Office Action, "the drawings alone indicate that the lower guideway *should be* adjustably engaged to the stable supports." Attach. 2 at 2-5 (emphasis added). The application states that by "moving one end of the lower guideway nearer to a point directly below an end of the upper guideway increases the speed and force of the ball approaching a player standing at a fixed point." Van Asselt Application at 3. Although that statement "does not describe exactly the subject matter claimed" in claim 8, the statement also does not disclaim or limit how and to what the lower guideway is engaged to. What it does disclose, however, in combination with the drawings, is that the end of the lower guideway is engaged/attached to the stable support and the end is moveable up and down on the stable support relative to the upper guideway. That is, the drawings and specification, taken as a whole, indicate that the lower guideway *is* adjustably engaged to the stable supports.

It is true that the application also states that "[i]t is preferred that the ends of the lower guideway are adjustably engaged with the ground." Van Asselt Application at 3.

However, as noted above, satisfying the written description requirement of 35 U.S.C. §112, first paragraph, does not mean that the specification must describe all species or embodiments that the claim encompasses. In this case, although the specification only describes one embodiment in which the term "adjustably engaged" is used, that does not mean a claim encompassing what is "described" in the drawings should be ignored.

Here, the written description clearly allows persons of ordinary skill in the art to recognize that the applicant invented what is claimed and, therefore, it is error to reject claim 8 under 35 U.S.C. § 112, first paragraph.

C. It is error to reject claims 1-5, 7-9, 11-15, 18, 19, 28 and 34 under 35 U.S.C. § 103(a)

1. Summary of the rejection

Claims 1-5, 7-9, 11-15, 18, 19, 28 and 34 stand rejected as being unpatentable, under 35 U.S.C. § 103(a), over U.S. Patent No. 3,630,521 to *Lingbeek* in view of U.S. Patent No. 3,086,775 to *Albert* and U.S. Patent No. 5,713,805 to *Scher et al.* or in the alternative U.S. Patent No. 5,460,364 to *Ring*.

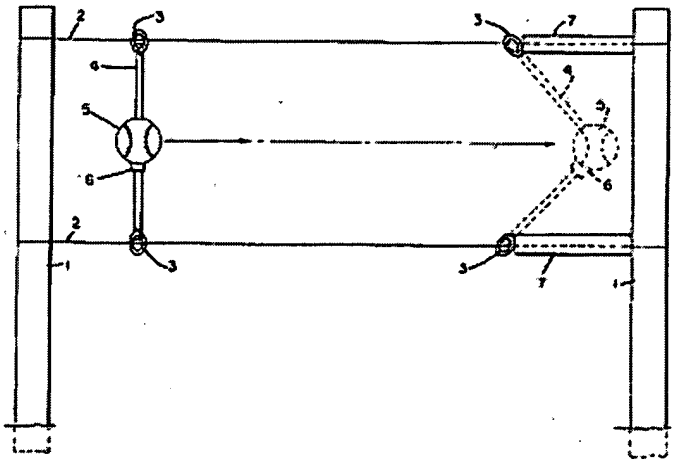
With regard to the claim 1, the basis for the rejection under 35 U.S.C. § 103(a) is that *Lingbeek* discloses every feature of the invention except for an "inclined upper guideway" but that *Albert* discloses varying the slope of a guideway and it would have been obvious to one of ordinary skill in the art at the time of the invention to have secured the upper guideway of *Lingbeek* in any suitable way including at an angle as disclosed in *Albert* in order to increase the rate of approach of the ball. Attach. 2 at 2-6.

Another basis for rejection under 35 U.S.C. § 103(a) is that *Lingbeek* discloses every feature of the invention recited in claim 1 except for a "substantially inelastic reciprocating means" but that *Scher et al.* discloses a baseball practice device wherein the reciprocating means can be either made of elastic or non-elastic material and that *Ring* discloses an apparatus wherein the reciprocating means can be fabricated from elastic or non-elastic materials and it would have been obvious to one of ordinary skill

in the art at the time of the invention to have substituted the elastic reciprocating means of *Lingbeek* with a substantially inelastic reciprocating means as shown in *Scher et al.* and *Ring* in order to accommodate and meet the strength of various players. Id.

2. Summary of the cited prior art

a. ***Lingbeek.*** *Lingbeek* discloses a baseball batting practice device as shown in Figure 1 of the patent (reproduced below). The invention is described as including two posts 1 (or trees, building, poles or other supports), two spaced apart wires 2, a ring 3 (or hooks or pulleys), elastic cord 4 (or rubber cord, cord, spring or the like), ball 5, tube 6, and two stops 7. As shown in Figure 1 of *Lingbeek*, the ball 5 and elastic cord 4 are shown in a first position by a solid line and an alternate position by a broken line. The arrow indicates the motion of the ball after being struck by a batter.



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b. ***Albert.*** *Albert* discloses a baseball batting practice device as shown in Figure 1 of the patent (reproduced below). The invention is described as including an upstanding tree 5, a branch 6, ground 7, a line 8 (preferably sheathed in plastic and having ends 9 and 10), a stake 11 driven into the ground, a guy rope 12, peg 13 and grooved wheel 14. Figure 2 of *Albert* (not reproduced here) shows a detail of the ball 25 suspended from the wheel 14.

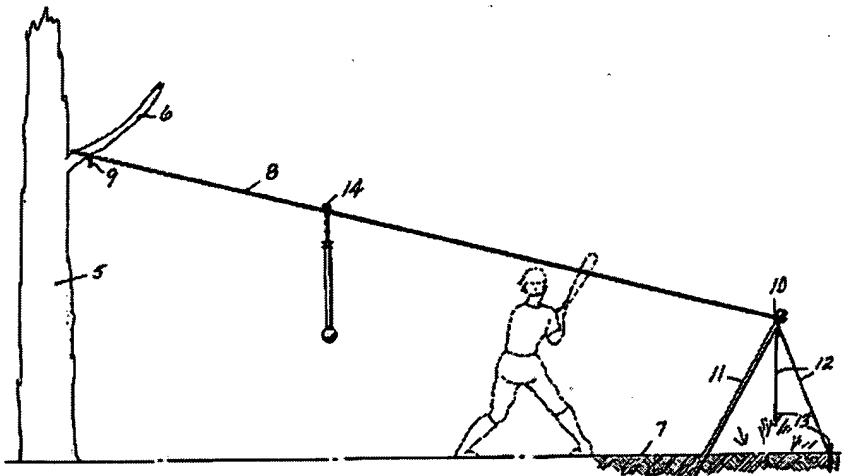


Fig. 1

c. ***Scher et al.*** *Scher et al.* also discloses a baseball batting practice device as shown in Figure 1 of the patent (reproduced below; note: other embodiments of the patent are not reproduced below). The embodiment of the invention shown in Figure 1 is described as including a base 1, vertical members 2, 3, Y-shaped horizontal member 6, horizontal members 7, 8, cord 19 (which may be a standard rope or "bungy" cord), ball 20, and hook-and-loop fastener 21.

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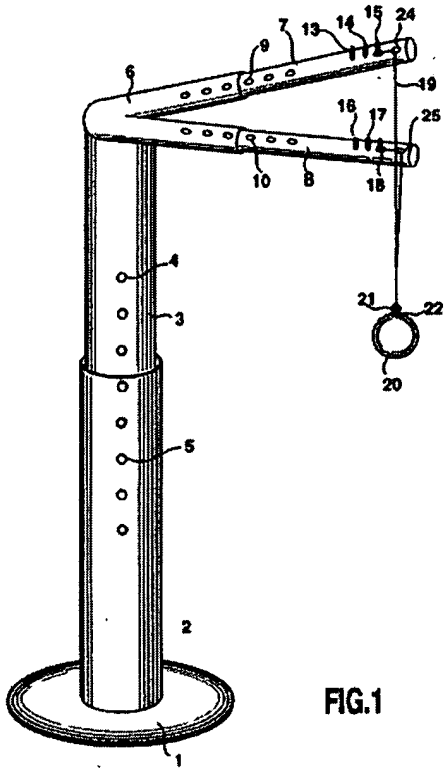
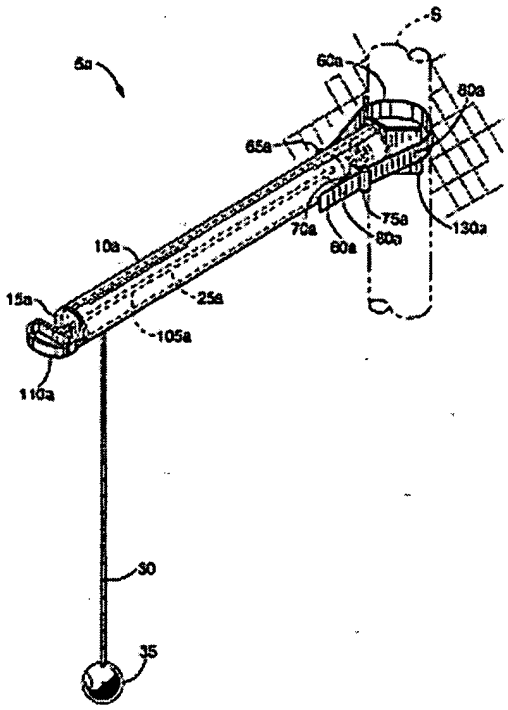


FIG.1

d. ***Ring.*** *Ring* discloses a portable ball batting apparatus 5 as shown in Figure 1 of the patent (reproduced below; note: other embodiments of the patent are not reproduced below). The embodiment of the invention shown in Figure 1 is described as including a support S (which may be a vertical or horizontal fence post or other structure pre-existing at a baseball facility and is not built or installed for each practice session), rigid or semi-rigid hollow elongated member 10 (made from metal or polymeric material), tether 30 (preferably made from a resilient material), ball 35, and post attachment means. As described in *Ring*, the tether wraps around the elongated member after the ball is struck by a batter and the energy imparted in the ball is transferred to the resilient tether causing it to stretch as it wraps around the member. That energy then is released as the tether unwinds.

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3. The references cited by the Examiner, taken as a whole, do not suggest the claimed subject matter.

The rejection of claims 1-5, 7-9, 11-15, 18, 19, 28 and 34, under 35 U.S.C. § 103(a), is in error because the Examiner did not establish a *prima facie* case of obviousness. In particular, the limitations "generally inclined upper guideway" recited in claim 1, a "slanted upper guideway" recited in independent claim 34, and "inelastic reciprocating means" recited in both claims 1 and 34 are not described or taught in any single or combination of prior art references relied on in the rejection and, therefore, those limitations render the claimed subject matter unobvious over the prior art.

A patent claim may not be allowed "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103(a) (2000). An obviousness analysis is based on four underlying factual inquiries, the well-

known *Graham* factors: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Kegel Co., Inc. v. AMF Bowling, Inc., 44 U.S.P.Q.2d 1123, 1130 (Fed. Cir. 1997). In the case where two or more references are cited and used to assert obviousness, the law requires that the references contain some "teaching, suggestion or reason" to combine the them. See Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). "The level of skill in the art may inform whether the artisan would find a suggestion to combine in the teachings of an exemplar of prior art. Where the level of skill is high, one may assume a keener appreciation of nuances taught by the prior art. Similarly, appreciation of the differences between the claims in suit and the scope of prior art references—a matter itself informed by the operative level of skill in the art—informs the question of whether to combine prior art references." McGinley v. Franklin Sports Inc., 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001).

As the Examiner acknowledges, *Lingbeek* fails to show each and every feature recited in amended claim 1. Attach. 2 at 2-6. In particular, *Lingbeek* fails to disclose an apparatus with a "generally inclined [or slanted, in the case of claim 34] upper guideway" or an "inelastic reciprocating means." Id. What *Lingbeek* does disclose is a device with parallel upper and lower guideways that are approximately horizontal to the ground, stretched between two spaced apart upright posts and spanned by an *elastic* cord with a ball connected thereto (see Figure 1 of *Lingbeek* shown above).

According to *Lingbeek*, the parallel upper and lower guideways, combined with the *elastic* nature of the cord, form an apparatus whereby the ball, after extending to the farthest position shown by the broken lie in Figure 1after being struck by a batter, returns to the batter "with approximately the same speed at which it was hit." In fact, the proportional speed and trajectory of the ball returning to the batter is an essential element of the teaching of *Lingbeek* (see col. 1, lines 5-6: "[the ball] return[s] to the batter at approximately the same speed at which it was hit"; col. 1 line 20-24:

"[a]nother object of this invention is to provide a device...[with] change of speed pitches according to the force the ball was hit"; col. 2, lines 20-23: "[the ball] snap[s] back to the batter with approximately the same speed as it was hit"; and col. 2, lines 27-28: "change of speed pitches are produced according to the force the ball was hit previously."). That is, due to the arrangement of the parallel and taut guideways that are spanned by an *elastic* cord, the speed of the returning ball is only a function of the force applied to it by the batter, not due to any mechanical arrangement of the guideways. Moreover, there are no stops disclosed in *Lingbeek* to the left of the apparatus. Inclining the upper guideway on the right side of the apparatus would cause the ball to rest against the left upright support because the elastic cord is under tension. That would destroy the utility of the disclosed invention. Thus, *Lingbeek* teaches away from inclining the upper guideway to alter the speed of the returning ball, since inclining the upper guideway would alter the ball's speed and would destroy the utility of the invention.

Albert teaches that raising one end of the upper guideway will increase the "rate of approach of the ball to the batter" (see *Albert*, col. 2, lines 31-33). That is, because the ball in *Albert* is suspended from the upper guideway and moves back to the batter by the force of gravity, raising the end of the upper guideway will cause the ball to drop farther (and, hence faster), upon its return to the batter after being struck. *Lingbeek*, as noted above, is concerned with maintaining the velocity of the ball upon returning to the player at approximately the same as it had as it left the player's bat. That essential feature of *Lingbeek* would be destroyed by raising one end of the upper guideway as disclosed in *Albert*. Indeed, that is why, as the Examiner points out in her detailed comments, *Lingbeek* fails to disclose an apparatus with a "generally inclined upper guideway."

The law requires that the references contain some "teaching, suggestion or reason" to combine the them. In this case, the Examiner asserts that the motivation is to "increase the rate of approach of the ball." Attach. 2 at 2-6. However, as noted above, *Lingbeek* teaches away from making a modification to achieve that result. Thus, one of

ordinary skill in the art would not have modified *Lingbeek* in view of the teaching of *Albert* by raising one end of the upper guideway.

With regard to the elasticity issue, as noted above, another essential feature of *Lingbeek* is the elastic nature of the cord. In fact, *Lingbeek* only discloses a cord that "allows suitable springy action" (see col. 1, lines 46-47). The elastic cord is necessary since the upper and lower guideways are parallel and taut. As taught by *Lingbeek*, the change in the ball's speed and trajectory upon returning to the batter is related to the force applied to the ball by the batter and the elastic nature of the cord. Thus, because the cord is elastic, a stronger batter could alter the ball's return speed and trajectory at a level that a weaker play could not by simply striking the ball harder. There is no teaching or suggestion in *Lingbeek* that the device should be operated differently for weak or strong players by modifying the arrangement of the components or substituting the elastic cord for an inelastic one. The *Lingbeek* device already accommodates the strength of various players. Thus, contrary to the Examiner's assertion, one of ordinary skill in the art at the time of the invention would not have substituted the elastic reciprocating means of *Lingbeek* with a substantially inelastic reciprocating means as disclosed in *Scher et al.*, and described by *Ring*, to accommodate and meet the strength of various players.

With regard to claim 34 in particular, the same remarks presented above with respect to claim 1 also apply with respect to claim 34.

Accordingly, because the cited prior art references by themselves and in combination do not disclose or teach the subject matter, as a whole, recited in claims 1 and 34, and therefore do not establish a *prima facie* case of obviousness, it is error to reject those claims under 35 U.S.C. § 103(a). Because claims 2-5, 7-9, 18-19 and 28 depend from claim 1, it is also error to reject those claims under 35 U.S.C. § 103(a).

D. It is error to reject claims 10, 16, 17, 20-26, 29-33 and 35 under 35 U.S.C. § 103(a)

1. Summary of the rejection

Claims 10, 16, 17, 20-26, 29-33 and 35 stand rejected as being unpatentable, under 35 U.S.C. § 103(a), over *Lingbeek* in view of *Albert* and *Scher et al.* or in the alternative to *Ring*, as applied to claim 1, and further in view of U.S. Patent No. 4,138,107 to *Janis*.

With regard to the rejected claims 10, 16, 17, 29 and 30, all of which depend from claim 1, the basis for the rejection under 35 U.S.C. § 103(a) is as follows. For claim 10, it is asserted that *Lingbeek*, as modified by the cited references, discloses every feature of the invention of claim 1 but does not disclose "wherein the reciprocating means comprises one upstanding line connected to the upper guideway and another associated upstanding line connected to the lower guideway" but that *Janis* discloses that feature and it would have been obvious to make *Lingbeek*'s single line into two separate lines as taught by *Janis* because two lines would limit the movement of the ball along the length of the line and provide better ball control. Attach. 2 at 2-9.

With regard to claims 16 and 17, it is asserted that *Lingbeek*, as modified as described above, discloses every feature of the invention of claim 1 but does not disclose "wherein the upper and lower guideways are made of a substantially rigid material" or "wherein the upper or lower guideway comprises a plastics track which is capable of receiving a runner to which the reciprocating means is connected," but that *Janis* discloses rigid guideways and plastic is well know for its rigidity and strength and it would have been an obvious functional equivalent. Id.

With regard to claim 29, the rejection is based on the assertion that *Lingbeek*, as modified by *Albert*, shows an upper guideway to be inclined but *Albert* only discloses an upper guideway. The Examiner has taken official notice "that the slack in a line, would provide an inelastic line the same resiliency or 'slack' that an elastic line inherently posses [sic], which in turn allows the ball to travel more freely along the

guideway(s)." Id. at 2-10. Thus "a lower guideway simply confines the movement of the ball and provides a more controlled practice device. Therefore, one of ordinary skill in the art would have used a slack, semi-slacked or taut lower guideway that was most readily available for the modified device of *Lingbeek* in order to achieve the desired end result." Id.

With regard to claim 30, the rejection is based on the assertion that while *Lingbeek* does not show the "wherein the portion of the one or more upstanding lines between the ball and the lower guideway is slack when the ball is at rest," *Albert* discloses the line to be slack (in Figure 2) and it would have further been obvious to use a slack line for the one or more upstanding lines of *Lingbeek* since it would allow the ball to travel more freely. Id.

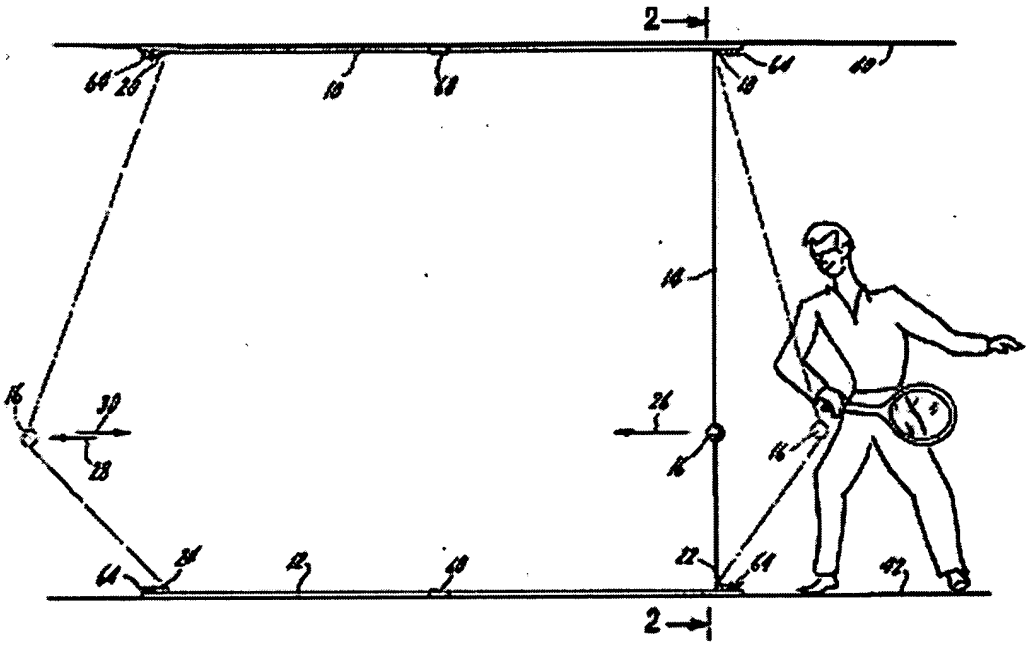
For claims 20, 21, 23-26, and 31-35, which do not depend from claim 1, the rejections is based on the assertions made with respect to previous claim rejections. See id. at 2-9 to 2-10.

For claim 22, the rejection is based on the assertion that *Lingbeek* discloses "wherein the upper and lower guideway comprises a string or rope." Id. at 2-9.

2. Summary of the cited prior art

a. *Lingbeek, Albert, Scher et al. and Ring.* See Section "C.2" for a brief description of the disclosures contained in those patents.

b. *Janis.* *Janis* discloses a ball batting practice device as shown in Figure 1 of the patent (reproduced below). The invention is described as including an upper rail 10 attached to a ceiling 40, lower rail 12 attached to a floor 42, elastic cord 14 stretched under tension, ball 16, stops 18, 20, 22, 24, couplers 68 (used to couple various lengths of rail), and wing nuts 64 (to secure the stops). As shown in Figure 1 of *Janis*, the ball 16 and elastic cord 14 are shown in a first position by a solid line and an alternate position by a broken line. The arrows indicates the motion of the ball after being struck by the batter.



3. The references cited by the Examiner, taken as a whole, do not suggest the claimed subject matter.

The rejection of claims 10, 16, 17, 29 and 30, under 35 U.S.C. § 103(a), is in error because the Examiner does not establish a *prima facie* case of obviousness with respect to claim 1. That is, if the Board accepts that it is error to reject claim 1 under 35 U.S.C. § 103(a), then it should find that it is error to reject claims 10, 16, 17, 29 and 30, all of which depend from claim 1. The additional reliance on *Janis*, by itself or in combination with the other cited art, does not establish a *prima facie* case of obviousness of those claims. For instance, *Janis* does not disclose a "generally inclined upper guideway" as recited in claim 1. *Janis* only discloses an apparatus connected to a horizontal ceiling and floor with "first and second parallel...rigid guide rails" (see col. 1, ll. 53-54; and claim 1: "comprising first and second rigid guide rails mounted in parallel"). This is not a case where a preferred embodiment is simply silent as to other configurations or species of a broadly disclosed invention. Rather, *Janis* only teaches a

horizontal arrangement for the upper guideway so there is no teaching or suggestion to use an inclined guideway.

With regard to claim 29, which recites "wherein the lower guideway between the first and second upstanding stable supports is slack when the ball is at rest," the Examiner relies on official notice to assert that the lower guideway would be slack. Attach. 2 at 2-10. That is, the Examiner asserts that the slack in a line would provide an inelastic line the same resiliency or "slack" that an elastic line inherently possesses, which in turn allows the ball to travel more freely along the guideways. Id. As best understood from the Examiner's assertion, an inelastic line that is not stretched taut between its ends, as in the case of the lower guideway shown in Figure 1, has some slack in it and that slack is the same as the resiliency that an elastic line inherently possesses.

Official notice requires that the rationale supporting an obviousness rejection be based on common knowledge in the art or well-known prior art. See M.P.E.P. § 2144.03 (citing cases). An Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being well-known in the art. Id.; In re Ahlert, 165 U.S.P.Q. 418, 420 (CCPA 1970). The facts noticed serve to fill a gap which might exist in the evidentiary showing and should not comprise the principle evidence upon which a rejection is based. In re Ahlert, 165 U.S.P.Q. at 420-21.

As set forth in Appellant's Amendment filed February 25, 2003, Appellant questioned the use of official notice as a substitute for finding an express or implied teaching in a reference being cited to reject the claims under 35 U.S.C. § 103(a). It is not clear that the Examiner's comparison of a slack inelastic line to an elastic line under tension is a fact capable of instant and unquestionable demonstration as being "well known" in the art generally, or supported by the references of record, especially since no basis for the statement has been provided. Appellant requested in its Amendment that that the data or facts supporting the above assertion be included in the record. No such data or facts were submitted. Appellant submits that one of ordinary skill in the

art, when viewing the present specification and cited art, would not have understood that a cord or wire-like guideway having some slack between its ends is the same as or interchangeable with a taut elastic line under tension having resiliency or elasticity properties. Thus, the use of official notice in this case is in error specifically with respect to claim 29 (but also with respect to all of the other rejected claims that recite the slack feature of the claimed invention if the Examiner is relying on official notice in rejecting those claims). At the very least, this is grounds to remand the case to the Examiner, per M.P.E.P. § 2144.03, to allow the Examiner to provide a response to Appellant's seasonal traverse of the official notice, and withdrawal of the finality of the Office Action.

The rejection of claims 20-26 and 31 (which do not depend from claim 1), under 35 U.S.C. § 103(a), was in error because the Examiner did not establish a *prima facie* case of obviousness with respect to those claims either. In particular, the subject matter as a whole recited in those claims, as discussed below, is not described or taught in any single or combination of prior art references relied on in the rejection and, therefore, it renders those claims unobvious over the prior art.

With regard to claim 20 (and claims 21-26, and 31, which depend from claim 20), that claim recites an embodiment of the invention similar to that recited in claim 1, except that the "substantially inelastic reciprocating means" recited in claim 1 is replaced with "a substantially inelastic upstanding line" recited in claim 20. *Janis*, while disclosing, as the Examiner suggests, that a reciprocating means can be a single line or two separate lines connected by a ball and the use of a slide where the line attaches to the guideway, does not disclose or teach other subject matter that is the same as that in claim 1. As the Examiner acknowledges with respect to claim 1, *Lingbeek* fails to show each and every feature recited in amended claim 1. Attach. 2 at 2-6. In particular, *Lingbeek* fails to disclose an apparatus with a "generally inclined upper guideway" or an "inelastic reciprocating means" as recited in claim 1. Id. Similarly, *Lingbeek* fails to show "an upper, generally inclined elongated guideway" and "a substantially inelastic upstanding line" or "a second substantially inelastic upstanding

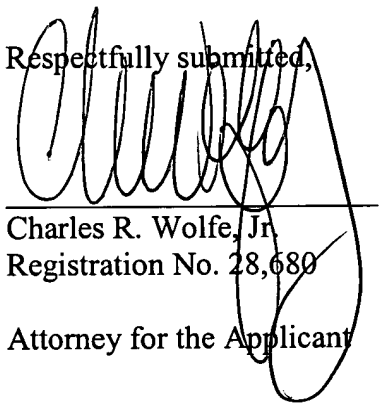
line" as recited in claim 20. *Janis* does not disclose "an upper, generally inclined elongated guideway" either. As described previously, *Janis* only discloses an apparatus connected to a horizontal ceiling and floor with "first and second parallel...rigid guide rails" (see col. 1, ll. 53-54; and claim 1: "comprising first and second rigid guide rails mounted in parallel"). Accordingly, *Lingbeek*, by itself or in combination with *Albert* and/or *Janis*, does not teach an inclined upper guideway. Thus, it is error to reject claim 20 because a *prima facie* case of obviousness is not established and, therefore, the subject matter of claim 20, as a whole, would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

With regard to claims 32, 33 and 35, *Janis* does not disclose "wherein the lower guideway is slack when the ball is at rest" as recited in independent claim 32, or "wherein the lower upstanding line is slack when the ball is at rest" as recited in claims 33 and 35. In fact, *Janis* discloses "rigid rails" (see col. 1, l. 54; claims 1-5; and Figures 1-6) and states that they are "attached" to the ceiling and floor with screws 44, which means the rails cannot be "slack" when the ball is at rest. Moreover, the elasticity of the elastic cord 14 that is strung between the rails so that it is taut (col. 2, l. 35) prevents the cord from ever becoming slack, either when the ball is at rest or after it has been struck. Thus, the slack feature of the present invention is not taught in *Janis*. Accordingly, *Lingbeek*, by itself or in combination with any of the other cited art, and in particular *Janis*, does not teach the slack feature of claims 32, 33and 35. Thus, the subject matter of those claims as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Conclusion

For all the reasons stated above, the Appellant requests that the Board reverse the examiner's rejections and instruct the examiner to confirm the patentability of the rejected claims and issue a notice of allowability.

Respectfully submitted,



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Date: November 3, 2003

APPENDIX 1

LISTING OF CLAIMS

LISTING OF CLAIMS:

Claim 1 (Previously Amended): Apparatus for use in playing and practicing ball games comprising generally inclined upper guideway, generally inclined or horizontal lower guideway, substantially inelastic reciprocating means connected to and freely moveable along said upper and lower guideways, a ball connected to said reciprocating means, a first upstanding stable support connected to the first ends of the upper and lower guideways, and a second, spaced apart, upstanding stable support connected to the second ends of the upper and lower guideways.

Claim 2 (Previously Amended): Apparatus according to claim 1 wherein the maximum height of the inclined upper guideway above ground level is greater than the length of the reciprocating means.

Claim 3 (Previously Amended): Apparatus according to claim 1 wherein the upper and lower guideways are substantially parallel.

Claim 4 (Previously Amended): Apparatus according to claim 1 wherein the upper and lower guideways lie in a plane which is generally normal to the ground.

Claim 5 (Previously Amended): Apparatus according to claim 1, wherein the upper and lower guideways lie in a plane which is inclined to the ground.

Claim 6 (Cancelled in Amendment After Final Rejection filed September 13, 2002).

Claim 7 (Previously Amended): Apparatus according to claim 1 wherein the first upstanding stable support is one of a wall and a pole and wherein the second upstanding stable support is one of a wall and a pole.

Claim 8 (Previously Amended): Apparatus according to claim 6, wherein the lower guideway is adjustably engaged to the stable support.

Claim 9 (Previously Amended): Apparatus according to claim 1, wherein the reciprocating means comprises one or more upstanding lines connected to the upper and lower guideways.

Claim 10 (Previously Amended): Apparatus according to claim 9 wherein the reciprocating means comprises one upstanding line connected to the upper guideway and another associated upstanding line connected to the lower guideway.

Claim 11 (Previously Amended): Apparatus according to claim 1, wherein the reciprocating means is connected to the upper and lower guideways means through a slide.

Claim 12 (Original): Apparatus according to claim 11 wherein the slide comprises a hinged clip, ring, rope slide or adjustable loop.

Claim 13 (Previously Amended): Apparatus according to claim 1, wherein the upper and lower guideways or the reciprocating means are made of a low friction material.

Claim 14 (Previously Amended): Apparatus according to claim 13 wherein the upper and lower guideways or the reciprocating means are made of plastics covered cord or wire.

Claim 15 (Previously Amended): Apparatus according to claim 1, wherein the upper and lower guideways and the reciprocating means are made from the same material.

Claim 16 (Previously Amended): Apparatus according to claim 1, wherein the upper and lower guideways are made of a substantially rigid material.

Claim 17 (Previously Amended): Apparatus according to claim 16 wherein the upper or lower guideway comprises a plastics track which is capable of receiving a runner to which the reciprocating means is connected.

Claim 18 (Previously Amended): Apparatus according to claim 1, wherein the ball can be connected at any point along the reciprocating means.

Claim 19 (Previously Amended): Apparatus according to claim 1, wherein the ball is one of a tennis ball, a baseball, a rounders ball, a cricket ball, a hockey ball, and a golf ball.

Claim 20 (Previously Amended): Apparatus for use in playing and practicing ball games, comprising a ball suspended by a substantially inelastic upstanding line

from an upper, generally inclined elongated guideway and connected by the same or a second substantially inelastic upstanding line to a lower, generally horizontal or inclined elongated guideway, a first upstanding stable support connected to the first ends of the upper and lower guideways, and a second, spaced apart, upstanding stable support connected to the second ends of the upper and lower guideways.

Claim 21 (Original): Apparatus according to claim 20 wherein the upper and lower guideways lie in a plane which is generally normal to the ground or in a plane which is inclined thereto.

Claim 22 (Previously Amended): Apparatus according to claim 20, wherein the upper and lower guideway comprises a string or rope.

Claim 23 (Previously Amended): Apparatus according to claim 20, wherein the upper or lower guideway or upstanding lines are coated with or formed from a material being of relatively low friction properties.

Claim 24 (Previously Amended): Apparatus according to claim 23, wherein the upper or lower guideway or upstanding lines are coated with or formed from a plastics material.

Claim 25 (Previously Amended): Apparatus according to claim 20, wherein the upstanding lines are connected to the upper or lower guideway by a slide.

Claim 26 (Original): Apparatus according to claim 25 wherein the slide comprises a loop or ring.

Claim 27 (Cancelled in Amendment filed February 19, 2002).

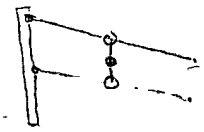
Claim 28 (Original): Apparatus according to claim 1, further comprising a guide rope and a peg, wherein one end of the guide rope is attached to the top of one of the first and second upstanding stable supports and the other end is attached to the peg and wherein the peg is connected to the ground.

Claim 29 (Original): Apparatus according to claim 1, wherein the lower guideway between the first and second upstanding stable supports is slack when the ball is at rest.

Claim 30 (Original): Apparatus according to claim 9, wherein the portion of the one or more 3, 4 or 10 upstanding lines between the ball and the lower guideway is slack when the ball is at rest.

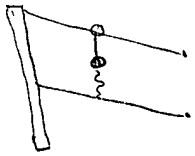
Claim 31 (Original): Apparatus according to claim 20, further comprising a guide rope and a peg, wherein one end of the guide rope is attached to the top of one of the first and second stable supports and the other end is attached to the peg and wherein the peg is connected to the ground.

Claim 32 (Original): Apparatus for use in playing and practicing ball games comprising generally inclined upper guideway, generally inclined or horizontal lower guideway, substantially inelastic reciprocating means connected to and freely moveable along said upper and lower guideways, a ball connected to said reciprocating means, and at least one upstanding stable support connected to the end of the upper and lower guideways, wherein the lower guideway is slack when the ball is at rest.

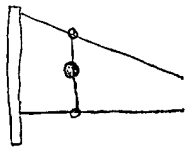


Claim requires at least one stable support

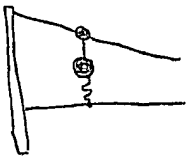
Claim 33 (Original): Apparatus according to claim 32, wherein the reciprocating means comprises a first upstanding line connected to the upper guideway and the ball and a second upstanding line connected to the ball and the lower guideway, wherein the lower upstanding line is slack when the ball is at rest.



Claim 34 (Original): Apparatus for use in playing and practicing ball games comprising slanted upper guideway, generally horizontal lower guideway, substantially inelastic reciprocating means connected to and freely moveable along said upper and lower guideways, a ball connected to said reciprocating means, and at least one upstanding stable support connected to the end of the upper and lower guideways.



Claim 35 (Original): Apparatus according to claim 34, wherein the reciprocating means comprises a first upstanding line connected to the upper guideway and the ball and a second upstanding line connected to the ball and the lower guideway, wherein the lower upstanding line is slack when the ball is at rest.



APPENDIX 2

COPY OF MAY 7, 2003, OFFICE ACTION FINALLY REJECTING PENDING CLAIMS

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ATTORNEYS AT LAW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,556	08/22/2000	Jan Abraham Van Asselt	112134-00102	2767

27557 7590 05/07/2003

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EXAMINER
ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
112134.0102
MAY 12 2003 KCS
Action Due
Amdt after final/
NTC of Appeal Due 8.7.03
LST Day 11.7.03

PTO-90C (Rev. 07-01)

IPE
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PATENT & TRADEMARK OFFICE
3634

Office Action Summary	Application No.	Applicant(s)	
	09/582,556	VAN ASSELT, JAN ABRAHAM	
	Examiner	Art Unit	
	Mitra Aryanpour	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-26 and 28-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-26 and 28-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for being dependent on a canceled claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. Claim 8 is dependent on claim 6, which was canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8, 29, 30, 32, 33 and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is insufficient support in the disclosure for the lower guideway to be slack. The disclosure on pages 6 merely states ". . . two positions of the lower guideway are shown in figure 1, these being shown in full line and broken line" and again on page 7, " . . . upper and lower guideways 1, 2 towards the limiting position shown in broken line". There is no clear and definite support in the disclosure for the lower guideway to be "slack". A mere reference that the lower guideway is shown in two positions does not provide support for the guideway to be "slack". No reference in the original specification and/or claims was made to have the lower guideway "slack", no additional explanation has been given in the original specification and/or claims as to the relationship of the

"slack" guideway to the remainder of the apparatus, and why it would be desirable to have such a feature, and how it would differ from a taut line? Applicant asserts that this feature exists, without providing proper support for its existence in the original application as filed.

Regarding claim 8, the disclosure provides support for the lower guideway to be attached to the stable support, however, the specification does not provide support for the lower guideway to be adjustably engaged (see page 3, lines 21-24 and page 4, lines 1-3). As best seen from the drawings the lower guideway should be adjustably connected to the stable supports, but specification indicates that the lower guideway are adjustably engaged with the ground. Therefore, it is unclear how the lower guideway is adjustably engaged with the ground? Unless the position of the stables is changed with respect to the ground!

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 7-9, 11-15, 18, 19, 28, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lingbeek (3,630,521) in view of Albert (3,086,775) and Scher et al (5,713,805) or in the alternative Ring (5,460,364).

Regarding claim 1, Lingbeek shows an apparatus for use in playing and practicing ball games comprising upper and lower guideways (2), reciprocating means (4) connected to and freely moveable along the upper and lower guideways (2), and a ball (5) connected to the

reciprocating means (4); the upper and lower guideways are substantially parallel, and lie in a plane which is generally normal to the ground (see figure 1). Lingbeek as disclosed above does not show the upper guide way to be inclined. Albert shows a practice device, wherein the rate of approach of the ball (25) to the player can be adjusted by varying the slope in the line (8). The ball is attached to an inelastic line. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have secured the upper guide way of Lingbeek in any suitable way including at an angle as shown by Albert in order to increase the rate of approach of the ball. Lingbeek as modified above additionally lacks a substantially inelastic reciprocating means. Scher et al shows a baseball practice device wherein the reciprocating means can be either made of elastic or non-elastic material (see claims 10 and 11). Ring also shows a ball batting practice apparatus, wherein the reciprocating means (30) can be fabricated from elastic (for weak hitters or younger players) or non-elastic (for strong hitters) materials (column 4, lines 4-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the elastic reciprocating means of Lingbeek with a substantially inelastic reciprocating means as it is claimed by Scher et al and described by Ring in order to accommodate and meet the strength of various players.

Regarding claim 2, Lingbeek as modified above shows the maximum height of the upper guideway above the ground level to be greater than the length of the reciprocating means (see figure 1).

Regarding claims 3 and 4, Lingbeek as modified above, shows the upper and lower guideways (2) are substantially parallel and are generally normal to the ground.

Regarding claim 5, Lingbeek as modified above in view of Albert, shows the upper guideway to be inclined with respect to the ground. Albert's device only shows an upper guideway, therefore, no discussion has been made with respect to the lower guideway. Official Notice is taken that varying the slope of a line in order to control the rate of approach of a ball is well known, and it would have been obvious to have inclined the upper and/or the lower guideway of Lingbeek's device in order to increase the rate of approach of the hit balls as it is also shown and taught by Albert.

Regarding claim 7, Lingbeek as modified above shows the upper and lower guideways being attached to a pole (1; see column 1, lines 40-42).

Regarding claim 8, Lingbeek as modified above shows the lower guideway to be adjustably engaged with the ground (the position of the support poles can be changed).

Regarding claim 9, Lingbeek as modified above shows the reciprocating means comprises an upstanding line (4) connected to the upper and lower guideways (2).

Regarding claims 11 and 12, Lingbeek as modified above shows the reciprocating means (4) is connected to the upper and lower guideways means (2) through a slide (3), wherein the slide is a ring (see figure 1).

Regarding claims 13-15, Lingbeek as modified above, shows the reciprocating means (4) is made of low friction material (it can be made of elastic or rubber, both of which are a form of plastic). Albert also shows the upper guide way to be made of a plastic covered line (column 1, lines 62-66); and the reciprocating means (23) to be partially covered by a plastic sleeve (30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a plastic cover for the modified device of Lingbeek such as the one described by

Albert in order to protect the guide and/or reciprocating means from damage due to repetitive use. It would have also been obvious to use this material for the guidelines and the reciprocating means in order to provide protection and to reduce cost of manufacturing.

Regarding claims 18 and 19, Lingbeek as modified above shows the ball can be connected at any point along the reciprocating line (4) using stop means (6) and the ball (5) can be of any size, shape or material desired (see column 1, lines 47 and 48).

Regarding claim 28, Lingbeek as modified above, does not show the posts (1) to have a guide rope and peg, but teaches that the stable supports can be posts, trees, poles, buildings, or any support sufficiently spaced to support the guideways (2). Albert further shows the stable support (11) to be additionally secured in place using ropes (12) and pegs (13). It would have been obvious in view of Albert to include ropes and pegs for the stable support of Lingbeek in order to add additional stability to the overall structure.

Regarding claim 34, see comments for claim 1.

6. Claims 10, 16, 17, 20-26, 29-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lingbeek (3,630,521) in view of Albert (3,086,775) and Scher et al (5,713,805) or in the alternative Ring (5,460,364), as applied to claim 1, and further in view of Janis (4,138,107).

Regarding claim 10, Lingbeek as modified above does not show the reciprocating means to be constructed of two upstanding lines. Janis shows the reciprocating means (14) can be made of one continuous line (figure 5) or a combination of two separate lines (figure 2) connected to the ball; the reciprocating means is connected to the upper and lower guideway means through a

slide (see figures 3 and 7), wherein the slide comprises a hook (column 3, lines 10-11). It would have been obvious to make the reciprocating line of Lingbeek of two separate lines, as taught by Janis, since having two separate lines, would limit the movement of the ball along the length of the line and provide better ball control.

Regarding claims 16 and 17, Lingbeek as modified above shows the upper and lower guideways to be made of a wire. It is well known that wires are considered as being a substantially rigid material (see column 1, lines 43-45). Nevertheless, for the sake of argument Janis shows the upper and lower guideways are made of a substantially rigid material (column 1, lines 52-58), wherein the guide ways form a track and are capable of receiving a runner (see figures 1-7). Janis does not indicate whether or not the guideways are made of plastic. Plastics are well known for their rigidity and strength, and considered art recognized equivalents to wires. To substitute the plastic material of Janis for the wire in the upper and lower guideways of Lingbeek would have been an obvious functional equivalent.

Regarding claim 20, see comments for claims 1 and 10.

Regarding claim 21, see comments for claim 4.

Regarding claim 22, Lingbeek as modified above shows the upper and lower guideway comprises a string or rope (see column 1, lines 43 and 44).

Regarding claims 23 and 24, see comments for claims 13 and 14.

Regarding claim 25, see comments for claim 11.

Regarding claim 26, see comments for claim 12.

Regarding claim 29, Lingbeek as modified in view of Albert, shows the upper guideway to be inclined with respect to the ground. Albert's device only has an upper line or guideway,

therefore, no discussion has been provided with respect to a lower guideway. Official Notice is taken that the slack in a line, would provide an inelastic line the same resiliency or "slack" that an elastic line inherently posses, which in turn allows the ball to travel more freely along the guideway(s). As can be seen from Albert the ball does not need the lower guideway to be able to travel freely on the upper guideway. The addition of a lower guideway simply confines the movement of the ball and provides a more controlled practice device. Therefore, one of ordinary skill in the art would have used a slack, semi-slacked or taut lower guideway that was most readily available for the modified device of Lingbeek in order to achieve the desired end result.

Regarding claim 30, again Lingbeek does not show the one or more upstanding lines between the ball to be slack when at rest. Albert shows the line to be slack (see figure 2). It would have further been obvious to use a slack line for the one or more upstanding lines of Lingbeek, since it would allow the ball to travel more freely.

Regarding claim 31, see comments for claim 28.

Regarding claim 32, see comments for claims 1 and 30. Regarding the limitation of "at least one upstanding stable support", Lingbeek shows at least one (1).

Regarding claim 33, see comments for claim 30.

Regarding claim 35, see comments for claim 30.

Response to Arguments

7. Applicant's arguments with respect to claims 1-5, 7-26, 28-35 has been considered but are not persuasive. Regarding applicant's assertion that *the specification does indicate, and with reasonable clarity, why the lower guideway is "slack" in the initial position and how that differs*

from a taut line, and goes on to explain, that there is only one reasonable conclusion that one of ordinary skill in the art could make regarding the nature of the lower guideway as depicted by the two positions of the guideway shown on Figure 1. Upon careful review of the specification as originally filed, it is concluded that there is no indication, or any reasonable degree of clarity for the "slack" in the lower guideway. Even the drawings are not consistent (see figure 4). For the sake of argument, if indeed the solid line is assumed to be the slack in the lower guideway, then there is no slack in the lower guideway of figure 4. The only thing Applicant has clearly defined with respect to the lower guideway is that it can be generally inclined and/or parallel to the upper guideway or it can be horizontal with respect to the ground. There is no description as to how the inelastic reciprocating means travels when struck, if it can travel at all, when the lower guideway is "slack", and how much slack should be provided in the lower guideway, in order for the reciprocating means to be able to travel effectively. In the Remarks dated 25 February 2003 (page 3), hypothetical dimensions (10.5 to 15 meters) for the lower guideway have been provided. However, such is not readily apparent from the specification, and it was not presented in the application when filed.

Although it is preferred but certainly not a requirement, to use the same language in the claims as it appears in the specification, nevertheless, some suggestion needs to already exist in the specification for the claimed subject matter. For the above reasons, and the lack of support in the specification as originally filed, it is concluded that the inventor(s), at the time the application was filed, did not have possession of the claimed subject matter.

Regarding applicant's assertion that Lingbeek teaches away from inclining the upper guideway to alter the speed of the returning ball. Lingbeek is silent regarding the upper guideway

being inclined. For a reference to be "silent" does not mean it teaches away from that feature, especially if the feature is well known, and it may well indicate that the patentee thought the feature so conventional, as not to require comments. Furthermore, it cannot be concluded for the sake of convenience that a reference teaches away, because it only shows a preferred embodiment.

Regarding applicant's remarks that Lingbeek already accommodates the strength of various players, thus there is no need to substitute the elastic reciprocating means for a substantially inelastic one. As applicant has pointed out in his remarks (page 3) a plastic-coated cord possesses some inherent flexibility. The same would be true for the reciprocating means, some degree of flexibility is desirable, therefore, there is nothing unobvious about varying the degree of flexibility in the reciprocating means of Lingbeek, whether it be for accommodating various players or to simply reduce the flexibility in the reciprocating line in order to achieve better control.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA
3 May 2003

APPENDIX 3

COPY OF MAY 23, 2003, INTERVIEW SUMMARY CONCERNING THE MAY 7, 2003, OFFICE ACTION

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,556	08/22/2000	Jan Abraham Van Asselt	112134-00102	2767

27557 7590 05/23/2003

BLANK ROME COMISKY & MCCAULEY LLP
900 17TH STREET, N.W., SUITE 1000
WASHINGTON, DC 20006

EXAMINER
ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/23/2003

OIPE JC34
NOV 04 2003
PATENT & TRADEMARK OFFICE

BLANK ROME LLP
MAY 28 2003
RECEIVED
COUNSELORS AT LAW

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
112134.0102
MAY 28 2003 pvn
Amend after final
Notice of appeal 8/7/03
Action Due Due Date

OIPE JC34
NOV 0 4 2003
PATENT & TRADEMARK OFFICE

Interview Summary	Application No. 09/582,556	Applicant(s) VAN ASSELT, JAN ABRAHAM	
	Examiner Mitra Aryanpour	Art Unit 3711	

All participants (applicant, applicant's representative, PTO personnel):

(1) *Mitra Aryanpour*. (3)_____.

(2) *Biran Higgins*. (4)_____.

Date of Interview: *21 and 22 May 2003*.

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☒ No.
If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: *N/A*.

Agreement with respect to the claims f)☐ was reached. g)☒ was not reached. h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *See Continuation Sheet*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Paul T. Sewell
Supervisory Patent Examiner
Group 3700
Examiner's signature, if required

OIPE JC34 NOV 0 4 2003 PATENT & TRADEMARK OFFICE

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
 (The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner t Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statem nt attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Higgins pointed out that not all the limitations of the claimed invention had been addressed. Specifically in claims that recited the limitation "a stable support", such langauge was not used to make the rejection. The Examiner pointed out that the cited references meet the claimed limitation. When addressing a claimed limitation, it is not required that the identical language be used to reject the claim, especially if the cited reference clearly shows and teaches that limitation. In the instant case the cited reference shows a pole, which is considered a "stable support". Applicant has failed to otherwise define "stable support", therefore, it is taken to mean a support that is securely placed into or on the ground or a support that securely holds the intended object..